

### **REMARKS**

This responds to the Office Action mailed on November 21, 2006.

Claims 3, 12, 15, 22 and 31 are amended and no claims are canceled or added; as a result, claims 1-31 remain pending in this application. The amendments to the claims correct minor typographical errors and improve readability of the claims. Further, claim 15 has been amended to more particularly differentiate the claim from claim 17. None of the amendments are in response to an art based rejection.

#### **Claim Objections**

Claims 3, 12, 15, 22 and 31 were objected to for informalities. In response, Applicant has amended the claims substantially as suggested in the Office Action. Applicant respectfully requests removal of the objections to claims 3, 12, 15, 22 and 31.

#### **Drawing Objections**

The Drawings were objected to for informalities. Submitted with this response are replacement drawings in which Figure 3 has been amended so that reference number 322 has been replaced with reference number 324. Applicant believes the amendment overcomes the objection because there are no longer two reference numbers used for "Service Description" elements. Applicant respectfully requests removal of the objection to the drawings.

#### **Double Patenting Rejection**

Claims 13-17 were provisionally rejected under a non-statutory double patenting rejection as being unpatentable over claims 13-17 of co-pending U.S. Patent Application No. 10/788,661 in view of Gatto (U.S. 6,916,247).

Claims 1-11, 13-17 and 20-30 were provisionally rejected under a non-statutory double patenting rejection as being unpatentable over claims 1-2, 5-6, 8-10, 13-16, 20-24, 28-29, 32-33, 35-37 and 40-43 of co-pending U.S. Patent Application No. 10/789,957 in view of Gatto (U.S. 6,916,247).

Applicant does not admit that the claims are obvious in view of U.S. Patent Application No. 10/788,661 and U.S. Patent Application No. 10/789,957. However, Applicant will consider

filing a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(b)(iv) to obviate these rejections when all other issues related to patentability of claims 1-17 and 20-30 have been resolved.

§101 Rejection of the Claims

Claims 1 and 20 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action asserted that claims 1 and 20 do not produce a “useful, concrete, and tangible result.” Further, the Office Action stated that “publishing the availability of a service does not require any transformation.” Applicant respectfully traverses the rejection because the claims produce a useful, concrete and tangible result.

As noted in the Guidelines for examination, “If the examiner determines that the claim does not entail the transformation of an article, then the examiner shall review the claim to determine if the claim provides a practical application that produces a useful, tangible and concrete result. In determining whether the claim is for a ‘practical application,’ **the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is ‘useful, tangible and concrete.’**” AT&T, 172 F.3d at 1358-59, 50 USPQ2d at 1452. *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* (hereinafter, the “Guidelines”), pg. 20, October 2005. (emphasis added). As noted above, the Office Action makes the statement that one element, “publishing the availability of a service” does not require any transformation. The Office Action apparently ignores the other elements of the claims, thus ignoring the final result achieved by the claimed invention.

Claims 1 and 20 do produce a useful, concrete and tangible result. Publishing the availability of a service is clearly useful to the systems and machines that desire to utilize the service. Further, claims 1 and 20 recite “processing one or more service requests between the gaming machine and the game update service.” Such processing is useful, concrete and tangible. Processing a service request is clearly useful to the machine making the request. Further, processing a request is concrete and tangible. The processing of a request requires transformations in the service provider and/or the requesting machine as part of the processing of the request. Further, the results of processing the request is repeatable, thus making the claim

concrete and tangible.

In view of the above, Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1 and 20.

§112 Rejection of the Claims

Claim 15 was rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Applicant has amended claim 15 such that claim 15 now recites that the request is for a “notification of a game content update”, thereby differentiating the claim from claim 17. Applicant respectfully submits that the amendment overcomes the rejection and requests reconsideration and the withdrawal of the rejection of claim 15.

§102 Rejection of the Claims

Claims 1-31 were rejected under 35 U.S.C. § 102(e) for anticipation by Gatto (U.S. 6,916,247). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation because the claims contain elements not found in Gatto.

For example, claim 1 recites “publishing the availability of the game update service on the gaming network” and further recites “receiving a request to register with the game update service from a gaming machine.” Claims 8, 13, 20 and 27 recite similar language. The Office Action states that Gatto, in Figs. 19 and 20, at column 13 lines 64-67, at column 15, lines 45-49 and 57-60, at column 16, lines 7-11, and at column 18 lines 4-6, teaches the recited language. Further, the Office Action states that Gatto teaches a game update service at column 15, lines 20-30. Applicant respectfully disagrees with this interpretation of Gatto. Applicant has reviewed

Gatto and can find no teaching of a game update service in Gatto. The cited section merely states that application software may be obtained from a remote server. Nowhere does Gatto disclose that a game update service that responds to update requests provides the application software.

Further, Applicant notes that the process described in Gatto is in fact opposite to the processes recited in Applicant's claims. In Gatto, the specialized device broadcasts its availability and a service registers with the device, specifying the events the service is interested in (see Gatto at column 14, lines 17-20). This is in contrast to Applicant's claims 1, 8, 13, 20 and 27, where the game update service publishes its availability and clients can discover and register with the service and then send events to the game update service.

In view of the above, Gatto does not teach or suggest each and every element of Applicant's claims 1, 8, 13, 20 and 27. Therefore Gatto does not anticipate claims 1, 8, 13, 20 and 27. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 8, 13, 20 and 27.

Claims 2- 7 depend either directly or indirectly from claim 1; claims 9-12 depend either directly or indirectly from claim 8; claims 14-19 depend either directly or indirectly from claim 13; claims 21-26 depend either directly or indirectly from claim 20; and claims 28-31 depend either directly or indirectly from claim 27. These dependent claims inherit the elements of their respective base claims and are therefore not anticipated by Gatto for at least the same reasons as discussed above regarding their respective base claims 1, 8, 13, 20 and 27. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 2-7, 9-12, 14-19, 21-26 and 28-31.

Additionally, claim 3 recites that the service request comprises "a request by the gaming machine for notification of a game content update." Claims 11, 15, 22 and 30 recite similar language. Further, claim 4 recites "issuing a notification of the game content update to the gaming machine in response to the game content change." Claims 12, 16, 23 and 31 recite similar language. The Office Action asserts that Gatto, at Fig. 20, at column 5, lines 1-2, and at column 14, lines 10-32 discloses the recited language. Applicant respectfully disagrees with this interpretation of Gatto. Applicant notes that the cited section merely describes in general terms the asynchronous notification of events. Nowhere does Gatto disclose that gaming machines

may issue requests to be notified of the availability of an update to game content. Further, Gatto does not teach that a request to download updated content is issued upon receipt of a notification that an update is available. As a result, Gatto does not teach each and every element of claims 3-4, 11-12, 15-16, 22-23 and 30-31. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 3-4, 11-12, 15-16, 22-23 and 30-31.

### **Reservation of Rights**

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art.

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

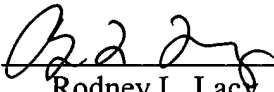
Respectfully submitted,

CHRISTOPHER W. BLACKBURN ET AL.

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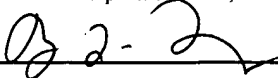
Date February 21, 2007

By   
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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 21<sup>st</sup> day of February 2007.

Rodney L. Lacy

Name



Signature

**IN THE DRAWINGS**

Corrected drawings are supplied herewith.

Enclosed is a Replacement Sheet showing the following amendment to Figure 3. Reference number 322 has been replaced with reference number 324 such that "Service Description" is now labeled consistently.